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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,005	07/29/2003	Gerome A. Haney	10990836-3	7339

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EXAMINER

NOVOSAD, JENNIFER ELEANORE

ART UNIT	PAPER NUMBER
	3634

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/629,005	HANEY, GEROME A.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jennifer E. Novosad	3634	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 11 May 2004.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 10-22,24-36,38 and 41 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 10-22,24-36,38 and 41 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 29 July 2003 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                     | Paper No(s)/Mail Date. _____ .  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____ .                                  |

## DETAILED ACTION

This final Office action is in response to the amendment of May 11, 2004 by which claims **10, 24, and 38** were amended and claims 2-9, 23, 37, 39, and 40 were canceled.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims **10-15, 17-21, 24-29, 31-35, 38, and 41** are rejected under 35 U.S.C. 102(b) as being anticipated by Kofstad '337.

Kofstad '337 discloses an assembly comprising a mount adapter (see Figure 3) having a first end (at left side of Figure 3) and a second end (at right side of Figure 3) whereby the rack mount is adjustable (see Figure 4) therebetween; a first mounting flange (70) orthogonally adjacent the first end and having protrusions (74 and 76); a second mounting flange (58) orthogonally adjacent to the second end and having protrusions (62 and 64) whereby the protrusions (74 and 72) extend towards each other and towards the opposite mounting flange, i.e., protrusion 74 extends towards flange 58, and protrusions (76 and 64) extend away from each other and from the respective mounting flange, i.e., protrusion 64 extends away from flange 70; each of the protrusions (76 and 64) engage mounting apertures (see Figure 7); the protrusions (76 and 64) are adapted to be engaged in mounting apertures (106) in a rack (40); and a rack rail (50 - see column 3, line 13) defining an outer channel (54) supported along the adjustable length and

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an inner channel (48) slidably supported by the outer channel which can thereby support equipment (42); the mounting flanges (70) contact the column flanges (28) when the rack mount is in a first position, i.e., the front surface of the flange 70 is placed on the front surface of element 28 so that a side of the mounting flanges (70) contacts a side of the column flanges (28); the protrusions (76) contact and slide the column flanges (28) when the rack mount is in a second position, i.e., the end surface of 76 will contact the surface of 28 when placed thereon thereby allowing the protrusions to slide in a direction (right to left) perpendicular to the longitudinal axis (up and down) of the column flanges below placed in the apertures; and the protrusions (76) engage the flange apertures when the rack mount is in a third position, i.e., see Figure 7, so that the protrusions support the rack mount therebetween and the protrusions being aligned therewith the apertures of the column flanges; the second position is between the first position and the third position. Kofstad '337 is also considered to disclose the structure capable of performing the method steps of claims 38-41 which includes positioning the rack mount assembly to span the column flanges (28) whereby the flanges (28) contact the flanges (70) of the assembly; then sliding the rack mount assembly relative to and on surface of the column flanges (28) so that protrusions (76) on the flanges (70) contact the flanges (28) and then engaging the apertures of the column flanges (28) with the protrusions (76); and adjusting a length of the assembly between the mounting flanges (see Figure 4).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kofstad '337 as applied to claims 10-15, 17-21, 24-29, 31-35, 38, and 41 above, and further in view of Harrington *et al.* '652.

Kofstad '337 discloses the assembly as advanced above.

The claim differs from Kofstad '337 in requiring the protrusions to include truncated cones.

Harrington *et al.* '652 teach that it is old in the art to have protrusions that define truncated cones (108 - see Figure 5) that are inserted into apertures.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the assembly of Kofstad '337 with protrusions defining truncated cones, for ease in economy and manufacture while allowing for increased securement of the adapter on the rack and ease in assembly therein.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims **10**, 16, 11-15, and 18-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11, respectively, of U.S. Patent No. 6,681,942. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art at the time the invention was made to have oriented the mounting flanges such that they would be perpendicular to the axis and that the flanges would extend toward each other, thereby increasing ease in assembly since the rack mount could be assembled to the column flanges with increased securement.

It is noted that the subject matter of claim **1** of U.S. Patent No. 6,681,942 is equivalent to the subject matter of the claimed combination of claims **10** and **16** of the instant application.

Claims **24**, 30, 25-29, and 32-36 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 12-22, respectively, of U.S. Patent No. 6,681,942. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art at the time the invention was made to have oriented the mounting flanges such that they would be perpendicular to the axis and that the flanges would extend toward each other, thereby increasing ease in assembly since the rack mount could be assembled to the column flanges with increased securement.

It is noted that the subject matter of claim **12** of U.S. Patent No. 6,681,942 is equivalent to the subject matter of the claimed combination of claims **24** and **30** of the instant application.

***Terminal Disclaimer***

The terminal disclaimer filed on May 11, 2004 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 6,681,9452 has been reviewed and is NOT accepted.

The disclaimer fee of \$55 in accordance with 37 CFR 1.20(d) has not been submitted, nor is there any authorization in the application file to charge a specified Deposit Account or credit card.

The person who signed the terminal disclaimer is not recognized as an officer of the assignee, and he/she has not been established as being authorized to act on behalf of the assignee. See MPEP § 324.

An attorney or agent, not of record, is not authorized to sign a terminal disclaimer in the capacity as an attorney or agent acting in a representative capacity as provided by 37 CFR 1.34 (a). See 37 CFR 1.321(b) and/or (c).

***Response to Arguments***

Applicant's arguments filed May 11, 2004 have been fully considered but they are not persuasive.

It is noted that applicant's arguments concerning the Kofstad and Harrington references are of a general nature, and even though applicant has amended claims 10, 24, and 38, since applicant has failed to point out the distinct differences between the Kofstad reference and the claims, the Koftsad reference is still considered to meet the limitations of these claims, as amended.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer E. Novosad whose telephone number is (703)-305-2872. The examiner can normally be reached on Monday-Thursday, 5:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl D. Friedman can be reached on (703)-308-0839. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jennifer E. Novosad/jen

July 8, 2004



Carl D. Friedman  
Supervisory Patent Examiner  
Group 3600